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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/687,151 | 10/12/2000 | John J. Sie | 19281-000600US | 8606 |

20350 7590 11/03/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BROWN, RUEBEN M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2611

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/687,151

Applicant(s)

SIE ET AL.

Examiner

Reuben M. Brown

Art Unit

2611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: 14-20 and 23.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See enclosed Advisory Action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____


CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed 9/14/2005 have been fully considered but they are not persuasive. With respect to the Election/Restriction, applicant argues that "it is not believed that the amendment changes the claims in a way that would overburden the office beyond what was previously filed...Specifying the transport media is not believed to warrant constructive election in a restriction". Examiner respectfully disagrees and points out that claim 14 is of divergent subject matter from claims 1 & 9, thereby requiring a different filed of search. Claim 14 is directed to a specific transport algorithm, such as a multicast or singlecast media, (725/97) whereas, claims 1 & 9, are directed to the length or portion of a movie stored at a user's set-top box, (725/89) which is distinct and independent from the instant claim 14.

With respect to applicant's argument regarding the merits of the rejection of claims 1 & 9, it is argued (on page 3) that Garfinkle does not contemplate anything like what is claimed. Examiner respectfully disagrees and points out that Garfinkle merely states, "For example, the lead-in segment may be in the order of two minutes long". The reference does not state any limitation on the storage parameter. It is clear that storage capacity is one of the determining factors in considering the length of storing a portion of a movie. One of ordinary skill in the art at the time the invention was made, would have been motivated to modify Garfinkle to store a

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longer duration of the movie, at least in order to allow the system more time to download the next segment.

On page 4, applicant requests a showing of proof of the Official Notice taken by the examiner. In response, examiner cites Ottesen (col. 20, lines 1-67 thru col. 21, lines 1-61 & col. 28, lines 45-55). Ottesen is in the same field of endeavor as Garfinkle, being directed to VOD systems that store at least a portion of the movie at a subscriber's terminal. In particular, Ottesen teaches that a set-top terminal 62 includes a direct access memory device (DASD 68) that buffers at least up to a thirty-minute portion of a movie. Ottesen teaches downloading and buffering the thirty minute portion in order to facilitate VCR-type control over the movie, (such as reverse or fast forward), (col. 20, lines 15-50; col. 28, lines 45-52), disclosed as presentation control window 90. By buffering the thirty-minute portion of the movie at a subscriber's set-top terminal 62, the system avoids the need for upstream communication and re-transmission of any segment within the thirty-minute portion, when the subscriber's VCR-type control command is within the instant thirty-minute portion.

Thus the claimed feature of the storing a first portion of a program, such that the first portion of the portion is at least $1/8^{\text{th}}$ or 15 minutes, would be provided by the combination of Garfinkle and Ottesen. Garfinkle teaches storing at least two minutes of a first portion of a movie, whereas Ottesen teaches storing at least thirty minutes of any portion of the movie.

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Any response to this action should be mailed to:

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or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown